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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/659,264 | 09/11/2003 | Nobuyuki Nakamura | 4492-0104P | 3531 |
| 2292 | 7590 | 08/23/2007 | EXAMINER | |
| BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747 | | | | LUONG, VINH |
| ART UNIT | | PAPER NUMBER | | |
| 3682 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

| | | |
|------------------------------|-----------------|--------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/659,264 | NAKAMURA, NOBUYUKI |
| | Examiner | Art Unit |
| | Vinh T. Luong | 3682 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 06 July 2007.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 and 3-6 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1 and 3-6 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 11 September 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.



Vinh T. Luong
Primary Examiner

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application
- 6) Other: _____

1. The amendment filed on July 6, 2007 has been entered.
2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear whether the term that appears at least twice, such as, "a resilient member" in Claim 6/1 refers to the same or different things. See double inclusion in MPEP 2173.05(o).

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 1 and 3-5 and Claim 6, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Kallin et al. (US Patent No. 4,729,311 cited by Applicant).

Regarding Claim 1, Kallin teaches a cam rotation control mechanism comprising:

a rotatable cam 66 (FIG. 2);
a clutch mechanism 48 for transmitting driving power of a rotating device 50-62 to the cam 66 and interrupting the transmission of driving power to the cam 66, the clutch *adapted to* interrupt the transmission of the driving power to the cam 66 when an operation of the control mechanism is stopped, or when the rotating device 50-62 is stopped, or an electric power to the rotating device 50-62 is interrupted; and

a home position setting device 78 for causing the cam 66 to turn to a home position when the transmission of driving power to the cam 66 is interrupted by the clutch mechanism 48, wherein the home position setting device 78 comprises a resilient member 78

(FIG. 4) having one end (at 76 in FIG. 4) attached to the cam 66 at a location adjacent a peripheral edge of the cam 66 and another end (at 78 in FIG. 4) outside an outer circumference of the cam 66 such that a stretched length of the resilient member 78 becomes shortest when the cam 66 is in its home position. *Ibid.* col. 3, line 39 through col. 4, line 63, and Claims 1-18.

Claim 1 and other claims below are anticipated by Kallin because Kallin teaches each positively claimed element in the claim. It is well settled that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform, thus, it does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138 (CCPA 1946). In addition, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then, it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). On the other hand, the functional limitations of a claim may not be given patentable weight where those limitations are inherent in a prior art reference. *In re Schreiber*, 44 USPQ2d 1429 (CAFC 1997). Put in another fashion, the claims drawn to an apparatus must distinguish from prior art in terms of structure rather than function. *In re Danly*, 120 USPQ 528 (CCPA 1959) and MPEP 2114.

Regarding Claim 3, the home position setting device 78 is operative to pull the cam 66 with a predetermined pulling force when the cam 66 is in the home position.

Regarding Claim 4, the resilient member 78 is a spring.

Regarding Claim 5, the rotating device 50-62 includes the motor 62 (id. col. 3, line 32+). Kallin’s motor 62 broadly includes a stepping motor.

Regarding claim 6, the home position setting device 78 comprises a resilient member 78 having one end attached to the cam 66 at a location adjacent a peripheral edge of the cam 66 (FIG. 4) and another end fixed at a location (unnumbered in FIG. 4) outside an outer circumference of the cam 66 such that the resilient member 78 rotates the rotating cam 66 to the home position.

6. Applicant's arguments filed July 6, 2007 have been fully considered but they are not persuasive.

At the outset, Applicant contended that the clutch 48 of Kallin is not "*adapted to* interrupt the transmission of the driving power to the cam 66 when an operation of the control mechanism is stopped, or when the rotating device 50-62 is stopped, or an electric power to the rotating device is interrupted."

The Examiner respectfully submits that that an element is "*adapted to*" perform a function is not a positive limitation but only requires the ability to so perform, thus, it does not constitute a limitation in any patentable sense. *In re Hutchison, supra*.

Second, Applicant asserted that Kallin fails to teach or suggested the cam and associated resilient member.

The above assertion is unsupported by substantial evidence in the record. Indeed, Kallin teaches the cam 66 and its associated resilient member 78 as evidenced in FIG. 4. Applicant's contention that Kallin's spring 78 is not adapted to return the cam to the home position is likewise unpersuasive. FIG 4 shows that the spring 78 is an overload or eccentric spring relative to the center of the cam 66. Thus, when the operation of the control mechanism is stopped, or when the rotating device 50-62 is stopped, or the electric power to the rotating device 50-62 is

Art Unit: 3682

interrupted, the elasticity of the spring 78 pulls the cam 66-2 and makes the cam 66-2 rotating counterclockwise toward its home position as claimed.

Third, Applicant alleged that, in the present invention, the cam is adapted to adjust the position of the arm, meanwhile, the cam of Kallin is adapted to transmit or interrupt the driving force.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the arm 2 shown in Applicant's FIGS. 1A-1C) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Lastly, Applicant averred that Kallin does not teach the resilient member having the shortest length in the home position. However, FIG. 4 shows and Kallin's specification, col. 3, line 63+ describes that “[t]he spring 78 is used to accelerate the output member 66 of the clutch 48 from the stopped position shown in FIG. 4 to *a position at which the control surface 82 engages the input member 64* to cause the second cam section 66-2 and the output member 66 to be rotated at a controlled rate of speed or rotation in the counterclockwise direction shown” (emphasis added). The position at which the control surface 82 engages the input member 64 corresponds to the home position in Applicant's claims. Common sense and/or standard knowledge in the standard physics text books teaches that, based on FIG. 4 of Kallin, when the spring 78 pulls the bearing 76 to rotate the cam 66-2 in the counterclockwise direction, the spring 78 is compressed, i.e., it must be at the shortest length as claimed. Simply put, Kallin expressly

Art Unit: 3682

or inherently teaches each and every claimed element, *a fortiori*, Applicant's claims are anticipated by Kallin as a matter of law. *Ex parte Smith*, 83 USPQ2d 1509 (B.P.A.I. 2007)

On the other hand, the Examiner respectfully submits that the thrust of Applicant's arguments is substantially relied on the "adapted to" clause. The Court has long laid these arguments to rest by pointing out that the claims drawn to an apparatus must distinguish from prior art in terms of structure rather than function. See *In re Hutchison* and MPEP 2114 *supra*.

For the forgoing, Applicant's request to reconsider and withdraw the previous rejection is respectfully declined.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 571-272-7109. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Luong

August 20, 2007



Vinh T. Luong
Primary Examiner